

REMARKS

Claims 1-31 remain pending in the present application. No new matter has been added.

Claim Rejections - 35 U.S.C. §112

The present office action states that Claims 1-31 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the presence of “Macintosh Operating System” is not proper.

In the previous OA mailed 5.27.07, Applicants respectfully disagreed with the rejection and pointed out section 2173.05(u) of the MPEP, “The presence of a trademark or trade name in a claim is not, per se, improper under 35 U.S.C. 112, second paragraph.” and section 608.01(v) of the MPEP, “If the trademark has a fixed and definite meaning, it constitutes sufficient identification unless some physical or chemical characteristic of the article or material is involved in the invention.”

Further, Applicants respectfully submit, **MPEP 608.01(v)** “Trademarks and Names Used in Trade [R-2]” The expressions “trademarks” and “names used in trade” as used below have the following meanings: Trademark: a word, letter, symbol, or device adopted by one manufacturer or merchant and used to identify and distinguish his or her product from those of others. It is a proprietary word, letter, symbol, or device pointing distinctly to the product of one producer.

Names Used in Trade: a nonproprietary name by which an article or product is known and called among traders or workers in the art, although it may not be so known by the public, generally. Names used in trade do not point to the product of one producer, but they identify a single article or product irrespective of producer. Names used in trade are permissible in patent applications if: (A) Their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a

claim, or (B) In this country, their meanings are well-known and satisfactorily defined in the literature. Condition (A) or (B) must be met” (emphasis added).

In the response to arguments section of the present OA mailed 12.27.07, the lines 12-15 of page 3, the OA provides, “On the contrary, the Apple Corporation has produced various Macintosh operating systems over the course of its existence beginning with the original classic and continuing today with its UNIX style memory management feature. Such a broad range of operating systems hardly defines a fixed and definite meaning as required under 35 U.S.C. § 112; rather, the use of the trademark suggest a limitation to identify or describe a particular material or product. (emphasis added).

Thus, Applicants respectfully submit that, in this country, and in the present Office Action, the meaning of the term “Macintosh Operating System” is well-known and satisfactorily defined in the literature as having a fixed and definite meaning to provide sufficient identification of the operating system characteristics. In addition, Applicants contend that the term Macintosh Operating System or Mac O/S is more than simply a trademark or trade name but is, in fact, a term of art as shown in the Office Action. In other words, Applicants contend that a reference to Mac O/S (e.g., Mac) or Windows O/S (e.g., PC) is presently the only way most, if not all, computer users refer to their computers in general. Further, most, if not all, software, hardware and periphery computer items provide similar segregation, e.g., Mac O/S and/or Windows O/S compatibility.

Further, Applicants respectfully submit that the meaning of the term “Macintosh Operating System” is clearly provided in the present Specification at least at page 139 lines 10-25: “Figure 20 is an exemplary logic/bit path block diagram 2000 showing utilization of a copyright compliance mechanism 300 (of Figure 3), for selectively controlling recording of copyrighted media received by a Macintosh® (sometimes referred to as Apple®) computer system, (e.g., system 210), in one embodiment of the present invention. Copyright compliance mechanism (CCM) 300 is, in one embodiment, installed and operational on Macintosh® operating system in the manner described

herein. Additionally, all rules and issues described herein regarding the CCM 300 and the media being controlled by the CCM 300 mechanism are enforced. The only difference is the method in which the CCM 300 apparatus is organized on the Macintosh® operating system (O/S). Although in one embodiment, CCM 300 is installed on the Macintosh® operating system, in another embodiment, the CCM 300 may be invoked by the Macintosh® operating system through a plurality of methods including system and periphery multimedia rendering applications (e.g., an iTunes player®, a CD player, a DVD player, a downloaded multimedia application, an MP3 player, or the like.)”

For these additional reasons, Applicants respectfully submit the rejection of Claims 1-31 under 35 U.S.C. § 112, second paragraph, based on the presence of the trademark “Macintosh Operating System” is improper and should be withdrawn as Macintosh operating system or MAC O/S has a fixed and definite meaning and there is no other term known to the Applicants which will provide as sufficient identification of the operating system characteristics as the term “Macintosh Operating System”.

Claim Rejections - 35 U.S.C. §102

Claims 1, 5-7, 9-13, 16-24 and 26-31

The present office action states that Claims 1, 5-7, 9-13, 16-24 and 26-31 are rejected under 35 U.S.C. § 102(e) as being anticipated by Wiser et al. (6,385,596). Applicants have reviewed the cited reference and respectfully submit that the embodiments of the present invention as recited in Claims 1, 5-7, 9-13, 16-24 and 26-31 are not anticipated by Wiser et al. for the following reasons.

Applicants respectfully submit that Claim 1 (and similarly Claims 12 and 23) includes the feature “A method for preventing unauthorized recording of media content on a Macintosh operating system comprising:

registering a compliance mechanism on a client system having said Macintosh operating system operating thereon, said compliance mechanism comprising:

a framework for validating said compliance mechanism on said client system; and

a multimedia component opened by said framework, said multimedia component for decrypting said media content on said client system; and

preventing decryption of said media content on said client system having said Macintosh operating system operating thereon if a portion of said compliance mechanism is invalidated.” (emphasis added).

According to the Federal Circuit, “[a]nticipation requires the disclosure in a single prior art reference of each claim under consideration” (W.L. Gore & Assocs. v. Garlock Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983)). However, it is not sufficient that the reference recite all the claimed elements. As stated by the Federal Circuit, the prior art reference must disclose each element of the claimed invention “arranged as in the claims” (emphasis added; Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)).

Applicants have reviewed Wiser et al. and do not understand Wiser et al. to anticipate the feature, “registering a compliance mechanism on a client system having said Macintosh operating system operating thereon, said compliance mechanism comprising: a framework for validating said compliance mechanism on said client system; and a multimedia component opened by said framework, said multimedia component for decrypting said media content on said client system” (emphasis added).

Applicants understand Wiser to teach a client-server architecture. Specifically, as shown in Figure 1 and described at least at Column 5, Applicants understand the system overview to provide a music distribution center 124 which operates with any number of client systems 126.

Music Distribution Center 124 includes a content manager 112, at least one delivery server 118 and an HTTP server 122. The content manager 112 maintains a

media information database 106, a master media file system 120 and a transaction database 130.

Client system 126 includes a media player 116 and a web browser 128.

Applicants respectfully submit the current Office Action improperly intertwines the server based aspects and client based aspects of Wiser in supporting the grounds of rejection.

For example, Applicants respectfully submits that the Office Action improperly combines the server side embodiments of Wiser, described in Figure 1B, for teaching “a compliance mechanism,” and the client side embodiment of Wiser, described in Figure 1A for anticipating the features clearly claimed as “registering a **compliance mechanism on a client system** having said Macintosh operating system operating thereon, said **compliance mechanism comprising**: a **framework** for validating said **compliance mechanism on said client system**; and a **multimedia component**” (emphasis added).

In particular, Applicant respectfully asserts that the client and server embodiments relied on in the present Office Action are mutually exclusive. In other words, Wiser teaches a client portion and a server portion of a system, but does not teach the a client system.

Applicants respectfully assert that combining different embodiments of Wiser is improper for an **anticipation** rejection, as Wiser does not disclose each element of the claimed invention “arranged as in the claims.” In other words, Applicant respectfully asserts that the Examiner has improperly combined different components of Wiser, and that anticipation of such a combination is not supported by Wiser.

As described above, since the prior art reference must disclose each element of the claimed invention “arranged as in the claims” to support an anticipation rejection; Applicants respectfully assert that relying on the teachings of the different embodiments

of Wiser is improper, as the combination does not disclose each element “as arranged in the claims.” Therefore, Applicants respectfully assert that the rejection of Claims 1, 5-7, 9-13, 16-24 and 26-31 under 35 U.S.C. § 102(a) is not proper, and that Claims 1, 5-7, 9-13, 16-24 and 26-31 thus overcome the rejection under 35 U.S.C. § 102(a).

Applicants have additionally reviewed Wiser et al. and do not understand Wiser et al. to anticipate the feature, “registering a compliance mechanism on a client system having said Macintosh operating system operating thereon, said compliance mechanism comprising: a framework for validating said compliance mechanism on said client system; and a multimedia component opened by said framework, said multimedia component for decrypting said media content on said client system” (emphasis added).

The present Office Action states at page 4 starting at approximately line 5, “[W]iser discloses a compliance mechanism including a Passport (col. 8:42-9:36); Media Data files (col. 6:48-8:41), wherein each Media Data file includes a transaction ID that is used to uniquely identify each copy of a media data file that is published; Media Player (col. 10:1-16), wherein the media player validates the passport and a voucher ID, and if successfully validated, then decrypts the media content. (col. 19:50-60)” (emphasis added).

The OA then states at page 4 approximately lines 10-14, “a framework to validate the compliance mechanism (means to validate the various security requirements including a transaction ID, the passport and the voucher ID); and a multimedia component for decrypting the media content on the client system (the media player). (emphasis added)

Thus, Applicants respectfully disagree that the compliance mechanism is shown as in the Claims. Specifically, and assuming merely for arguendo that the comparison as provided on page 4 of the present Office Action is proper, the OA provides a “means to validate” which was defined on the same page as the media player and a multimedia

component which the OA provides as “the media player” (emphasis added). Thus, the Arguments in the present OA merely provides a media player.

As such, Applicants do not understand the OA or Wiser to provide a “compliance mechanism comprising: a framework for validating said compliance mechanism on said client system; and a multimedia component opened by said framework, said multimedia component for decrypting said media content on said client system.”

For this further reason, Applicants respectfully assert that the rejection of Claims 1, 5-7, 9-13, 16-24 and 26-31 under 35 U.S.C. § 102(a) is not proper, and that Claims 1, 5-7, 9-13, 16-24 and 26-31 thus overcome the rejection under 35 U.S.C. § 102(a).

Furthermore, Applicants respectfully submit that Claim 12 (and similarly Claim 23) clearly recites the feature “disabling output of said media content on said client system having said Macintosh operating system operating thereon if a portion of said compliance mechanism is invalidated.” Applicants have reviewed Wiser et al. and do not understand Wiser et al. to anticipate disabling output. In contrast, Applicants understand Wiser et al. to teach the media player being unable to decrypt the media if the passport is not valid or existing.

Applicants respectfully submit that there is a large and distinct difference between a media player being unable to decrypt media and a media player that is able to play media but the output on the client system being disabled (emphasis added).

For this reason, Applicants do not understand Wiser et al. to anticipate the features of Claims 12 and 23. As such, Applicants respectfully state that Claims 12 and 23 are allowable.

With respect to Claims 5-7, 9-11, 13, 16-22, 24 and 26-31, Applicants respectfully state that Claims 5-7, 9-11, 13, 16-22, 24 and 26-31 depend from the

allowable Independent Claims 1, 12 and 23 and recite further features of the present claimed invention. Therefore, Applicants respectfully state that Claims 5-7, 9-11, 13, 16-22, 24 and 26-31 are also allowable as pending from allowable base Claims.

Rejection under 103(a)

Claims 2-4, 14-15 and 25

In the Office Action, the Examiner rejected Claims 2-4, 14-15 and 25 under 35 USC 103(a) as being unpatentable over Wiser et al. and further in view of Curran et al. (4,525,599). Applicants have reviewed the cited reference and respectfully submit that the present invention is not rendered obvious over Wiser et al. in view of Curran et al. for the following rationale.

Applicants respectfully submit that Claim 1 (and similarly Claims 12 and 23) includes the feature “A method for preventing unauthorized recording of media content on a Macintosh operating system comprising:

registering a compliance mechanism on a client system having said Macintosh operating system operating thereon, said compliance mechanism comprising:

a framework for validating said compliance mechanism on said client system; and

a multimedia component opened by said framework, said multimedia component for decrypting said media content on said client system; and

preventing decryption of said media content on said client system having said Macintosh operating system operating thereon **if a portion of said compliance mechanism is invalidated.**” (emphasis added).

For the reasons previously provided herein, Applicants respectfully submit that Claims 1, 12 and 23 are not render obvious by Wiser et al. Moreover, the combination of Curran et al. does not overcome the shortcomings of Wiser et al. As such, Applicants respectfully submit that Claims 1, 12 and 23 are presently allowable.

With respect to Claims 2-4, Applicants respectfully submit that Claims 2-4 depend from the allowable Claim 1 and recite further features of the present claimed invention. Therefore, Applicants respectfully state that Claims 2-4 are allowable as pending from an allowable base Claim.

With respect to Claims 14-15, Applicants respectfully submit that Claims 14-15 depend from the allowable Claim 12 and recite further features of the present claimed invention. Therefore, Applicants submit that Claims 14-15 are allowable as pending from an allowable base Claim.

With respect to Claim 25, Applicants respectfully submit that Claim 25 depends from the allowable Claim 23 and recites further features of the present claimed invention. Therefore, Applicants submit that Claim 25 is allowable as pending from an allowable base Claim.

Claim 8

The present Office Action rejects Claim 8 under 35 USC 103(a) as being unpatentable over Wiser et al. in view of official notice. Applicants have reviewed the rejection of record and respectfully submit that the present invention is not rendered obvious over Wiser et al. in view of Curran et al. for the following rationale.

With respect to Claim 8, Applicants respectfully submit that Claim 8 depends from the allowable Claim 1 and recites further features of the present claimed invention. Therefore, Applicants respectfully state that Claim 8 is allowable as pending from an allowable base Claim.

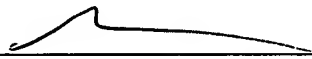
CONCLUSION

Based on the arguments presented above, Applicants respectfully assert that Claims 1-31 overcome the rejections of record, and therefore, Applicants respectfully solicit allowance of these Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,
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